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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,145	07/03/2002	Nicole Zitzmann	080618-0241	6322
22428	7590	10/09/2008	EXAMINER	
FOLEY AND LARDNER LLP			CRUZ, KATHRIEN ANN	
SUITE 500				
3000 K STREET NW			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20007			1617	
			MAIL DATE	DELIVERY MODE
			10/09/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/031,145	ZITZMANN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	KATHRIEN CRUZ	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 February 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 33,35 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 33, 35 and 38-40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

Claims 33, 35 and 38-40 are presented for prosecution.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

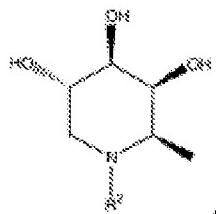
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 33, 35, 38 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Zitzmann (U.S. Patent 7,256,005, where hereinafter referred to as '005)

The applied reference has a common inventor with the instant application.

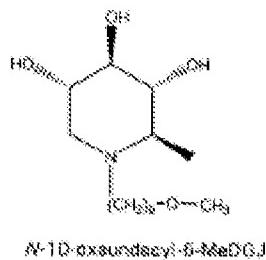
Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

'005 teach that formula I as follows:



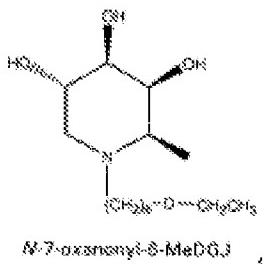
Preferably, R<sub>2</sub> is C<sub>7-18</sub> alkyl (Column 6, line 55 and Column 9, lines 25-33).

'005 teaches formula I with N-10-oxaundecyl-d-MeDGJ as follows:



(Column 10, lines 25-34).

'005 teach formula I with N-7-oxanonyl-6-MeDGJ as follow:



(Column 10, lines 25-34).

These compounds anticipate instant compounds set forth in claims 33, 35, 38 and 40, therefore 35, U.S.C 102(e) deemed proper.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

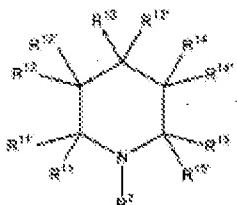
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 33, 35 and 38-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10 of U.S. Patent No. 7,256,005 (where hereinafter referred to as '005).

'005 teaches

Claim 10 illustrates formula 1 as the following:



wherein each substituents R<sub>11</sub>, R<sub>11'</sub>, R<sub>12</sub>, R<sub>12'</sub>, R<sub>13</sub>, R<sub>13'</sub>, R<sub>14</sub>, R<sub>14'</sub>, R<sub>15</sub>, R<sub>15'</sub> is selected, independently from each other, from a group consisting of -H; -OH; -F; -el; -Br; -I; -NH<sub>2</sub>; alkyl- and dialkylamino; linear or branched C<sub>1-6</sub> alkyl, C<sub>2-6</sub> alkenyl and alkynyl; aralkyl; linear or branched C<sub>1-6</sub> alkoxy; aryloxy; aralkoxy; - (alkyleneloxy(alkyl); -CN; -NO<sub>2</sub>; -COOH, -COO(alkyl); -COOlaryl); - C(O)NHIC~e alkyl); -C(O)NHLaryl); sulfonyl; (C~e alkyl)sulfonyl; arylsulfonyl; sulfamoyl, (Cl-e alkyl)sulfamoyl; (Cl-e alkyl)thio; (Cl-e alkyl)sulfonamide; arylsulfonamide; -NHNH<sub>2</sub>; -NHOH; aryl; and heteroaryl, wherein each substituent may be the same or different.

R<sup>2</sup> and -R<sup>4</sup>~e substituents selected independently of each other from a group consisting of linear C<sub>7-18</sub> alkyl, substituted C<sub>1-8</sub> alkyl, branched C<sub>3-18</sub> alkyl, C<sub>2-18</sub> alkenyl and alkynyl, and aralkyl; wherein each **linear C<sub>7-8</sub> alkyl**, branched C<sub>3-8</sub> alkyl, C<sub>2-8</sub> alkenyl and alkynyl, and aralkyl optionally may be substituted, and each substituted C<sub>1-18</sub> alkyl is substituted with one or more groups independently selected from a group consisting of-

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OH; -F; -C1; -Br; -I; - NH2; alkyl- and dialkylamino; linear or **branched C<sub>1-6</sub> alkyl**, C<sub>2-6</sub> alkenyl and alkynyl; aralkyl; linear or branched C<sub>1-6</sub> alkoxy, aryloxy; aralkoxy; -CN, -NO<sub>2</sub>, -COOH, -COO(alkyl); - COO(aryl); -C(O)NH(C<sub>1-6</sub> alkyl); -C(O)NH(aryl); sulfonyl; (C<sub>1-6</sub> alkyl)sulfonyl; arylsulfonyl; sulfamoyl, (C<sub>1-6</sub> alkyl)sulfamoyl; (C<sub>1-6</sub> alkyl)thio; (C<sub>1-6</sub> alkyl)sulfonamide; arylsulfonamide; - NHNH<sub>2</sub>; and -NHOH.

As such, the claims of the instant Application and the patented claims would have been obvious variations of the other to one of ordinary skill in the art because '005 patent encompasses the compounds in instant claims 38-40 because of formula 1 of the patent disclose the base structure with the appropriate hydroxyl groups in the R<sub>12-14</sub> and a methyl in the R<sub>15</sub> position.

### **Conclusion**

Claims 33, 35 and 38-40 are rejected.

No claims allowed.

### **Communication**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHRIEN CRUZ whose telephone number is

(571)270-5238. The examiner can normally be reached on Mon - Thurs 7:00am - 5:00pm with every Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KATHRIEN CRUZ/  
Examiner, Art Unit 1617

/JENNIFER M KIM/

Primary Examiner, Art Unit 1617